

II. REMARKS

The Examiner is requested to reconsider the application in view of the foregoing amendment and the following remarks.

Respectfully, and generally for the reasons set forth below, the objections and rejections and each ground therefor -- to the extent not rendered moot by the foregoing Amendment -- are traversed. Generally, it is believed that the amendment adds no new matter.

Commencing on page 2 of the Office Action, claims 6-13 have been rejected pursuant to 35 U.S.C. Sec. 112, first paragraph. The Examiner contends that it is unclear what is meant by the limitations in the claims.

In response, the rejection is respectfully traversed as improper pursuant to 35 USC Sec. 132, and an explanation and further information is requested. Sec 112, first paragraph, refers to enablement, while the reasoning of the rejection pertains to unclear limitations in the claims, which seems to be a Sec. 112, second paragraph rejection. Accordingly, and respectfully, Applicant does not know how to respond.

In good faith effort to advance prosecution, the claims 6-13 have been amended to add clarity. If the Examiner believes that the amendment does not address the rejection, an Interview or other opportunity to respond is respectfully requested.

On page 3, the Sec. 112, first paragraph, rejection is applied to claims 14-15. The Examiner contends that the written description requirement does not adequately describe the limitation of: "lawn on a portion of at least one of the mats."

In response, the rejection is respectfully traversed. The Examiner's attention is drawn to the specification at page 19, lines 8-10 and Figures 4-5, noting that lawn 34 in Fig. 4 (and Fig. 5) is shown on a portion of at least one of the mats in Fig. 5. It is respectfully submitted that Fig. 4 in view of Fig. 5, together with the specification text, explicitly or implicitly, provide a written description integral to perform the claimed invention.

Commencing on page 3 of the Office Action, claims 1-15 have been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that the claims are obvious over Milstein, in view of Mykreantz and Otwell.

In response, the Applicant respectfully traverses the rejection. Claim 2 (the Examiner treats claim 2 as the broadest claim) requires forming a design for a garden and forming pieces corresponding to the design... (harvesting ... transporting...) and installing the pieces... according to the design. As the steps of forming pieces and installing the pieces are carried out according to the design, the design must be preexisting. No cited art shows a preexisting design carried out by forming more than one piece, as is more precisely stated in the claim requirements as a whole.

As per claim 1, an analogous difference exists over the cited art. Claim 1 requires forming a design for a garden and implementing the design by forming a piece corresponding to a portion of the design ... (transporting...) and installing the piece... in accordance with the design. As the step of implementing is carried out according to the design, the design must be preexisting. Generally, no cited art shows a preexisting design carried out by forming a piece corresponding to a portion of the design..., as is more precisely stated in the claim requirements as a whole.

As no cited art teaches the claim requirements individually, no combination of the cited art can render the claims obvious as a whole.

Additionally, as to a reason to combine the cited art, the Office Action refers on page 5 to "the well-known advantages of that combination." The contention is respectfully traversed as an improper reason to combine. Also, the cited art contemplates principles of operation and intended purposes contrary to the combinative reasoning of the Office Action in rejecting the claims. For example, Mykrantz teaches that the garden is to be planted at different times of the year (abstract) as does Otwell (Fig. 2), while Milstein teaches the opposite

at Col. 2, lines 51-53 etc. and Milstein teaches wildflower mats, which is not consistent with the shrubs of Otwell (col. 1, line 29); and Otwell and Mykrantz teach against harvesting and transport of the gardens. Collectively the cited art cannot be properly combined and modified to reach the claimed invention, noting that hindsight selection inspired by Applicant's claims is improper under Sec. 103.

Further, the Office Action contends that "the cited steps of implementing and installing a garden are well-known and inherent to the art of landscaping and are disclosed in the background of numerous patents" and cites to Milstein and Mykrantz. However, neither Milstein nor Mykrantz teach the precisely claimed step of implementing or the precisely claimed step of installing. A reference is therefore required to establish the "well-known and inherent" contention upon which withholding a patent is premised.

In sum, the rejection pursuant to 35 U.S.C. Sec. 103 is respectfully traversed as follows:

- (1) Not all claim requirements are shown in the cited art.
- (2) The reasoning of the rejection would render the construction of the cited art inoperable for its intended purposes.
- (3) The reasoning of the rejection would change the principles of operation of the cited art.
- (4) There was no motivation or suggestion in the art, as of the filing date of the priority date of the instant application that would have prompted one skilled in the art to make the modification proposed in the Office Action.

With regard to a Terminal Disclaimer, such document was filed in this application on March 11, 2005.

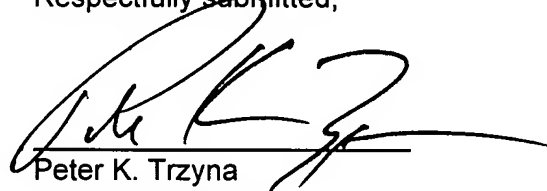
As to the other "prior art made of record," Applicant respectfully does not concede that Lewis is prior art.

The application, as amended, is believed to be in condition for allowance, and favorable action is requested. If the prosecution of this case can be in any way advanced by a telephone discussion, the Examiner is requested to call the undersigned at (312) 240-0824.

APPLICANT CLAIMS SMALL ENTITY STATUS. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,



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